

REMARKS

Claims 1-6, 12-14 and 22-25 are pending in this application. By this Amendment, claims 1, 3, 22 and 23 are amended, claim 21 is canceled, without prejudice to or disclaimer of the subject matter recited therein, and claims 24 and 25 are added. No new matter is added. Reconsideration of the application is respectfully requested.

The courtesies extended to Applicant's representative by Examiners Patterson and Pyon at the interview held April 20, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview.

I. Full Review By Supervisory Patent Examiner Is Requested

In accordance with MPEP §707.02, because this application has been pending for more than five years and because there have been more than three Office Actions, a careful and thorough review by the Supervisory Patent Examiner is respectfully requested, and it is respectfully requested that the Patent Office make every effort to conclude the prosecution of this application. As stated in this section of the MPEP, this application should be considered "special" by the Patent Office.

II. Incorrect Date To Which The Office Action Is Responsive

The Office Action states that Applicants' arguments that the previous action should be responsive to the March 1, 2005 Appeal Brief, is not persuasive because Applicants have not provided evidence that the Appeal Brief was received by the Patent Office prior to August 3, 2005. As discussed during the personal interview, Applicants respectfully submit that such evidence was filed with the August 3, 2005 Confirmation of Telephone Conference and Resubmission of Appeal Brief. A copy of the Patent Office receipt indicating receipt of the evidence is attached herewith. A copy of the Patent Office receipt of the original submission of the Appeal Brief on March 1, 2005, which was filed with the August 3, 2005

Resubmission, is also submitted for the Examiner's convenience. Therefore, Applicants respectfully request that the Patent Office correct its record of the receipt date of the Appeal Brief.

III. The Pending Claims Define Patentable Subject Matter

The Office Action rejects claims 1, 2, 21 and 22 under 35 U.S.C. §102(b) over U.S. Patent No. 5,193,711 to Hirata et al. (Hirata). The rejection of canceled claim 21 is moot. The rejection of the remaining claims is respectfully traversed.

As discussed and suggested by the Examiners during the interview, claim 1 is amended to more positively recite the structure of the article. Therefore, claim 1 recites that the article comprises a mark that is positioned, as a result of injection, at an inner surface of a sidewall portion of a cylindrical molded body between the upper and lower edges of the insert. The position of the mark corresponds to a position on the inner surface that is covered by the insert. The insert is bonded solely to said outer surface of the sidewall portion substantially without wrinkles and without injected material on an outer surface of the insert. A portion of these features was originally recited in canceled claim 21.

As discussed during the interview, the insert is a soft "sheet-shaped" insert and the injection is made directly between the upper and lower edges of the insert, that is, directly on the inner side of the insert. As a result of this process, the appearance of the article becomes better because a mark appears on the inner surface of the cylindrical body at a position corresponding to a position on the inner surface that is covered by the insert, and there are no wrinkles or extra injection material.

As discussed during the interview, Hitara specifically discloses at col. 6, lines 54-64 that most of resin injected through the inlet port may flow along the inner side of the label. In other words, some of the resin flows on the outer surface of the label. In addition, as discussed during the interview, the mark of the injection appears on the bottom surface of the

article in Hirata, because the injection is made on the bottom surface and the material flows along the label, as shown in Fig. 2(A). Thus, in Hirata, the mark is not made at the inner surface of the sidewall portion of the label.

Therefore, Hirata does not teach or suggest a mark that is positioned, as a result of injection, at an inner surface of a sidewall portion of a cylindrical molded body between the upper and lower edges of the insert so as to be at a position corresponding to a position on the inner surface that is covered by the insert, whereby the insert is bonded solely to said outer surface of the sidewall portion substantially without wrinkles and without injected material on an outer surface of the insert, as recited in claim 1.

Claims 2 and 22 are allowable for their dependence on claim 1, as well as for the additional features they recite. For example, claim 22 recites that the mark is positioned only at the inner surface of the sidewall portion while being closer to the upper edge than the lower edge of the insert in an axial direction of the cylindrical article and only at a position corresponding to a position on the inner surface that is covered by the insert. As discussed above, Hirata creates the mark on the bottom wall. Hirata's bottom wall is closer to the lower edge than the upper edge of the insert.

At least for these reasons, Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claims 3-6, 12-14 and 23 under 35 U.S.C. §103(a) over Hirata in view of Japanese Patent No. 6246777 to Suzuki et al. (Suzuki) and Japanese Patent No. 03286815 to Asahi Chemical (Asahi). This rejection is respectfully traversed.

Claim 3 is amended similarly to claim 1. Therefore, claim 3 recites injecting a molten resin through the injection gate opening toward the molded body inner surface of the sidewall portion at a portion between the upper and lower edges of the insert so as to be at a position corresponding to a portion on the molded body inner surface that is covered by the insert. Claim 3 also recites that the insert is solely bonded to the molded body outer surface of the

sidewall portion of the cylindrical molded body substantially without wrinkles and without injected material on an outer surface of the insert.

As discussed and agreed to during the interview, and similar to claim 1, Hirata does not teach or suggest these features. Neither Suzuki nor Asahi overcomes Hirata's deficiencies.

Moreover, the Office Action acknowledges that Hirata fails to disclose a core which is a pull-out molded unit, but alleges that Suzuki teaches this feature. The Office Action's alleged motivation for combining Hirata and Suzuki is that one of ordinary skill in the art would have recognized the advantage of Suzuki depending on the desired adhesion to both layers of the end product.

However, as discussed in the December 1, 2005 Amendment, Suzuki and Hirata are not combinable because Hirata specifically teaches injecting resin to the bottom wall section to mold it together with the container body, whereas Suzuki teaches that the bottom portion of the container is attached after the container is molded. Thus, combining Hirata and Suzuki would result in destroying the principle of operation of Hirata. In addition, combining Hirata and Suzuki would result in changing the position of injection in Hirata, which also destroys the principle of operation of Hirata. Further, such a motivation is derived solely based on the impermissible hindsight knowledge gained from Applicants' disclosure. Therefore, one of ordinary skill in the art would not have been motivated to combine Hirata and Suzuki in the way proposed by the Office Action. Thus, claim 3 is patentable over the applied references.

Claims 4-6, 12-14 and 23 are allowable for their dependence on claim 3, as well as the additional features they recite. Withdrawal of the rejection is respectfully requested.

New claims 24 and 25 recite that the cylindrical molded body is formed without a bottom wall. These claims are allowable at least for their respective dependence on claims 1 and 3, as well as for their additional features.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-6, 12-14 and 22-25 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Mario A. Costantino
Registration No. 33,565

JAO:KXH

Attachments:

Petition for Extension of Time
Request for Continued Examination
Copy of PTO receipt of March 1, 2005 Appeal Brief
Copy of PTO receipt of August 3, 2005 Confirmation of Telephone Conference
& Resubmission of Appeal Brief

Date: July 21, 2006

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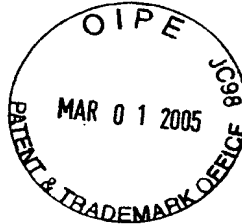
Name of Applicant: Hideyuki KIMURA et al.

Serial No.: 09/674,077

Atty. File No.: 107714

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The following papers have been filed:

Confirmation of Telephone Conference and Resubmission of Appeal Brief (with a copy of Patent Office date-stamped receipt, Appeal Brief Transmittal and Appeal Brief).

Name of Applicant: Hideyuki KIMURA et al.

Serial No.: 09/674,077

Atty. File No.: 107714

Title (New Cases):

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